# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/863,232 | 05/21/2001 | Greg Arnold | PALM-3649.US.P | 9948 |

7590      07/21/2008

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

| EXAMINER |
|---|
| SHIN, KYUNG H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2143 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/21/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
| **Office Action Summary** | 09/863,232 | ARNOLD ET AL. |
| | Examiner | Art Unit | |
| | KYUNG H. SHIN | 2143 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *09 April 2008*.
2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-24* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
       Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## *Response to Amendment*

1.     This application was filed 5/21/2001.

2.     Claims **1 - 24** are pending.  Independent Claims are **1, 12 and 21.**

## *Response to Arguments*

3.    Applicant's arguments filed **4/9/2008** have been fully considered but they are not

persuasive.

3.1    Applicant argues, user accounting versus device accounting (Remarks Page 3, 6).

       Applicant has mentioned that there is a fundamental difference between

accounting information based on a user as opposed to a device.   Applicant mentioned

that one user can have multiple devices.   But, one device can have multiple users.

The accounting or profile information for each device and each user in each situation

would be cognizant of the particular operational environment.   In one situation, the

accounting information for the device must recognize that multiple users are using the

device.   On the other hand, the accounting information for the user must recognize that

a user has multiple devices.   Accounting information must take into account how many

users and how many devices are attached to this particular account. The accounting

information is data that is manipulated by the computer systems performing the

synchronization procedure.   This change would not change the operation of Multer

since information such accounting data can still be synchronized between two

computing systems.

Multer discloses the management of accounting information.   (Multer col 17, ll 15-20; col 32, ll 14-17: accounting information updated and stored on server)   And, the Multer and Coppinger combination discloses a server for the registration, storage, and management of accounting information for a particular wireless (mobile computing) device including information designating a user for the particular device.  (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless or mobile device accounting information with a network connected server)

3.2   Applicant argues there is no disclosure of a complement of accounting information, only the creation of an account (Remarks Page 3, 7)

Coppinger discloses the creation of an account.   In addition, Coppinger discloses a complement of information within an account.  (see Coppinger paragraph [0059]: creation and complement of accounting information) and the usage of an account (Coppinger para 44, ll 4-10: accessible via the Internet (suitable passwords and accounts presumed to be in place))

3.3   Applicant argues version information (Remarks Pages 3, 11).

Multer discloses versioning utilizing a version number per object. (Multer col 12, ll 10-12), and each application has an application object.   Multer discloses the processing of application programs, its version information, and the capability to match (i.e. synchronize) applications between systems (i.e. handheld devices).  (Multer col 12, ll 10-12; col 15, ll 10-11; col 15, ll 27-30: application information processed)

3.4   Applicant argues that a datapack or equivalent token does not "causes said

account to be modified by said remote server" (Remarks page 4, 13, 14)

Multer discloses that the data packages are not after the fact logs of

synchronization procedures.   The datapack is a set of procedures required for updating

one computer system and placing it in synchronization with another computer system

whether handheld or mobile computing systems.   (Multer para 010, ll 48-51: steps

necessary for applying data packages to the local format required for the type of

information)

Multer discloses that the datapack information is applied to update the information.

This disclosure indicates that the data pack is not an after the fact data entity but an

entity that causes (applying information) the accounting (information, data) to be

updated.

Multer discloses that the datapack is equivalent to the token.   It is not a

requirement to disclose a token, when the prior art named entity, the datapack,

performs an equivalent function.   A token is defined as an entity to identify information.

A token causes the account information to be modified, and Multer's datapack causes

the particular accounting information and data on the handheld device or mobile

computing device to be modified.   Multer discloses a data package (datapack), which is

utilized to identify information.   (Multer col 10, ll 26-31; col 37, ll 62-65: data package,

change information)

In addition, Multer's data pack is not a record of transactions that have already

been completed. The datapack is a series of transactions. There is no disclosure

within the prior art that the datapack is an after the fact entity.


3.5    Applicant on page 7 states that Coppinger teaches accounting information for a

single wireless device and has absolutely nothing to do with a second wireless device.

Then, on Page 8 applicant states that Coppinger teaches wireless synchronization

directly between wireless devices or multiple devices. Coppinger discloses a server

system acting as an intermediary between wireless or mobile computing devices.

Coppinger provides accounting information on a device basis as per claimed limitation.

Coppinger discloses communications between a wireless device and a server.

(Coppinger para 009, ll 1-13: application program transferred for communications

between wireless device and server)


3.6    Applicant argues the determination of new information.

        Applicant states that Multer determines information is new because it is on the

remote server (Remarks Page 4). Then applicant states that Multer determines

information is new because of its interaction with the second device (Remarks Page

12). Both situations applicant states are incorrect for the particular situation. This

disclosure is one example of a determination of new information that must be

synchronized between the two computing systems. The claimed invention discloses

that the server determines when new information needs to be added or synched

between a first and second mobile computing devices. Multer discloses that the server

determines when information is new and needs to be synched between the two mobile

computing systems. The accounting information must be accessed by the server in

order to determine that said accounting information contains new information.

3.7   Applicant argues the "dependent claims". (Remarks Pages 15, 16)

   Arguments for dependent claims are based upon above arguments for

independent claims 1, 12, 21. The successful responses to arguments for independent

claims 1, 12, 21, also successfully respond to the current arguments against the

dependent claims 2-11, 13-20, 22-24.

3.8   To teach away, a reference must criticize or discourage a particular embodiment

of an invention within a prior art. There is no disclosure in Multer that discredits,

discourages the usage of information on a device basis. Accounting information is

information about a particular entity, whether it is a user or a device. The prior art's

treatment of a user is equivalent to Applicant invention's treatment of a device. The

Applicant accounting information maintained for the device can be application and

application version information. The prior art discloses that the accounting information

maintained for the user can be application and application version information. (Multer

col 8, II 40-44) The information maintained for Applicant's claimed invention and

referenced prior art are equivalent.

   The combination of Multer and Coppinger disclose the claim limitations of the

claimed invention and does not render the combination inoperable.

Applicant is reminded that, "the prior art's mere disclosure of more than one

alternative does not constitute a teaching away from any of these alternatives because

such disclosure does not criticize, discredit, or otherwise discourage the solution

claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

(refer MPEP 2145.X.D.1)

3.9    The claim limitations have been amended to replace "handheld" with "mobile

computing" for the type of device.    This does not change the basis of the rejection since

a handheld device is one example of a mobile computing device.

Multer and Coppinger disclose the processing of data such as application

programs and the capability to synchronize applications between systems whether

handheld devices or mobile computing devices.    Multer discloses the datapack an

equivalent entity to the token to indicate the required modification in order to

synchronize two computing system.    Coppinger discloses the usage of device

accounting information equivalent to the user accounting information disclosed by

Multer.    Multer discloses (Multer col 15, ll 10-11; col 15, ll 27-30: application information

processed; Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless

(mobile computing) device accounting information on a network connected server; para

071, ll 28-37: communication connection between server and other wireless (mobile

computing) device)

Therefore, the rejection of claims 1 - 24 is proper and maintained herein.

## *Claim Rejections - 35 USC § 103*

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

5.      Claims **1 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over

**Multer et al.** (US Patent No. 6,757,696) in view of **Coppinger et al.** (US PGPUB No.

**20010046862**).

**Regarding Claim 1**, Multer discloses a method of transferring information comprising

the steps of:

b)  modifying said account to identify an information that resides on said remote

server but not on said second mobile computing device; (Multer col 17, ll 15-20;

col 32, ll 14-17: accounting information updated and stored on server)

Multer discloses wherein said remote server automatically determining, from

said account that said information is new to said second handheld device and in

response thereto for automatically downloading said information to said second

mobile computing device. (Multer col 34, ll 23-29: user information updated (i.e. new

information)) Multer does not specifically disclose the capability for a remote server,

and accessing an account stored on said remote server said account reserved for a

second mobile computing device,.

However, Coppinger discloses:

a) at a remote server, responsive to a receiving signal from a first mobile computing

device, accessing an account stored on said remote server, said account

reserved for a second mobile computing device, said account describing

information that is not stored in said second mobile computing device;

(Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile

computing) device accounting information on a network connected server)

c) responsive to establishing a connection with said second mobile computing

device. (Coppinger para 071, ll 28-37: communication connection between server

and other wireless (mobile computing) device)

It would have been obvious to one of ordinary skill in the art to modify Multer for

a remote server and accessing an account stored on said remote server plus

establishing a connection with said second mobile computing device as taught by

Coppinger.  One of ordinary skill in the art would have been motivated to employ the

teachings of Coppinger in order to enable the additional and extended capability for

the transfer over the wireless communication link and execution of transferred

application programs on a handheld wireless device.  (Coppinger para 003, ll 7-13: "

*… Recently developed wireless devices permit a program to be transferred via the*

*wireless link (e.g., downloaded) for storage in the memory and for execution as an*

*application program.  Such an application program may define unique displays for*

*acquiring data input by the user and provide for transfer of resulting data via the*

*wireless link (e.g., upload) to a conventional desktop computer. ... ")*

**Regarding Claim 2**, Multer discloses a method as described in Claim 1 further

comprising the step of said remote server receiving a token identifying said information

and said second mobile computing device, and wherein said token causes said account

to be modified by said remote server. (Multer col 37, ll 62-65: data pack (i.e. token) used

for information transfer utilized for update)

**Regarding Claims 3, 14**, Multer discloses a method, system as described in Claims 1,

12 wherein the first and said second mobile computing or said sender and said receiver

mobile computing are portable electronic computer systems. (Multer col 4, ll 27-36: two

devices (i.e. handheld devices) in communication)

**Regarding Claims 4, 15, 23**, Multer discloses a method, system as described in Claims

1, 12, 21 wherein said information is a version of an application program. (Multer col 12,

ll 10-12; col 12, ll 16-20; col 13, ll 3-7: version information processed)

**Regarding Claims 5, 16, 24**, Multer discloses a method, system as described in Claims

4, 15, 21 wherein said account comprises an application version record table

comprising an entry for each application stored in said second mobile computing device

and wherein each entry comprises: an application identifier; a version identifier; and a

user identifier. (Multer col 38, ll 3-5 col 38, ll 8-15; col 38, ll 55-59: identifiers utilized to

designate contents within table entries)

**Regarding Claim 6**, Multer discloses a method as described in Claim 1 wherein the step of automatically downloading said information to said second mobile computing device, of step d), is performed only if said first mobile computing device has authority to download to said second mobile computing device. (Multer col 33, ll 13-17; col 34, ll 23-29; col 5, ll 17-21: authentication for device based on account information, download information)

**Regarding Claims 7, 18**, Multer discloses a method, system as described in Claims 6, 17 wherein said authority is established via an express grant of permission from said second mobile computing device to said first mobile computing device. (Multer col 34, ll 16-19: authorization for device based on account information)

**Regarding Claims 8, 19**, Multer discloses a method, system as described in Claims 6, 17 wherein said authority is established via a user confirmation that is made in response to a user message displayed on a display screen of said second mobile computing device. (Multer col 12, ll 29-36; col 32, ll 23-28: user interface)

**Regarding Claims 9, 20**, Multer discloses a method, system as described in Claims 1, 12 wherein said remote server is a web based server. (Multer col 31, ll 21-23: web based (i.e. HTTP) server)

**Regarding Claim 10**, Multer disclose a method as described in Claim 1 wherein said

step d) is performed within a synchronization process between said remote server and

said second mobile computing device. (Multer col 7, ll 58-64; col 14, ll 18-19:

synchronization process for information within server and handheld device)

**Regarding Claim 11**, Multer disclose a method as described in Claim 1 wherein the

step d) is performed within a synchronization process between a host computer system

and said second mobile computing device. (Multer col 7, ll 58-64; col 14, ll 18-19:

synchronization process for information in server and two devices (i.e. host system and

handheld device))

**Regarding Claim 12**, Multer discloses a system comprising:

  a) a receiver mobile computing device; (Multer col 4, ll 25-36; col 5, ll 17-21:

     receiver system (i.e. handheld device))

  c) a sender mobile computing device for causing said account to be modified to

     identify an information that resides on said remote server but not on said receiver

     mobile computing device; (Multer col 33, ll 13-17: update information within

     server system)

  d) wherein said receiver mobile computing device is for establishing a connection

     with said remote server; (Multer col 5, ll 10-17; col 8, ll 16-19: handheld device

     communicating through connection between server and handheld device) and

Multer discloses wherein said remote server is for automatically determining, from said account that said information is new to said receiver mobile computing device and automatically for downloading said information to said receiver mobile computing device. (Multer col 17, ll 15-20; col 32, ll 14-17; col 16, l 50: server management system for accounting information; col 34, ll 23-29: information updated (i.e. new information)) Multer does not specifically disclose a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in the receiver mobile computing device.

However, Coppinger discloses:

b) a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in the receiver mobile computing device; (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile computing) device accounting information on a network connected server)

It would have been obvious to one of ordinary skill in the art to modify Multer for a remote server containing an account which describes a complement of information stored in the receiver mobile as taught by Coppinger.  One of ordinary skill in the art would have been motivated to employ the teachings of Coppinger in order to enable the additional and extended capability for the transfer over the wireless communication link and execution of transferred application programs on a handheld wireless device. (Coppinger para 003, ll 7-13)

**Regarding Claim 13**, Multer discloses a system as described in Claim 12 wherein said

sender mobile computing is for sending said remote server a token identifying both said

information and said receiver mobile computing and wherein said token causes said

remote server to modify said account. (Multer col 5, ll 17-21; col 6, ll 16-20; col 37, ll 62-

65: data pack (i.e. token) utilized to modify user information)

**Regarding Claim 17**, Multer discloses a system as described in Claim 12 wherein said

remote server is also for determining if said sender mobile computing device has

authority to download to said receiver mobile computing device as a precursor to

downloading said information to said receiver mobile computing device. (Multer col 4, ll

25-36; col 6, ll 16-20: authorization for device, download information to device)

**Regarding Claim 21**, Multer discloses a system comprising:

    a) a receiver mobile computing computer; (Multer col 4, ll 25-36; col 5, ll 17-21:

        receiver system (i.e. handheld device))

    c) a sender mobile computing computer for causing said account to be modified to

        identify an information that resides on said web based server but not on said

        receiver mobile computing computer; (Multer col 17, ll 15-20: update accounting

        information managed within management (i.e. web based)server)

    d) wherein said receiver mobile computing computer is for establishing a connection

        with said web based server; (Multer col 5, ll 10-17; col 6, ll 16-20: handheld

device communicating through connection between server and handheld device)

Multer discloses wherein said web based server automatically determines, from said account, that said information is new to said receiver mobile computing computer, also determines if said sender mobile computing computer has authority to download to said receiver mobile computing computer, and, if so, automatically downloads said information to said receiver handheld computer. (Multer col 34, ll 23-29: update user information (i.e. new information)) Multer does specifically disclose the capability for a web based server containing an account reserved for said receiver mobile computing computer which describes a complement of information stored in the receiver mobile computing computer.

However, Coppinger discloses:

b) a web based server containing an account reserved for said receiver mobile computing computer which describes a complement of information stored in the receiver mobile computing computer; (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile computing) device accounting information on a network connected server; para 032, ll 8-13; para 035, ll 1-5: web server)

It would have been obvious to one of ordinary skill in the art to modify Multer for a web based server with an account which describes a complement of information stored in the receiver mobile computing computer as taught by Coppinger. One of ordinary skill in the art would have been motivated to employ the teachings of Coppinger in order to enable the additional and extended capability for the transfer over the wireless communication link and execution of transferred application

programs on a handheld wireless device.  (Coppinger para 003, ll 7-13)


**Regarding Claim 22**, Multer discloses a system as described in Claim 21 wherein said

sender mobile computing is for sending said remote server a token identifying both said

information and said receiver mobile computing and wherein said token causes the web

based server to modify said account. (Multer col 17, ll 15-20; col 37, ll 62-65: data pack

(i.e. token) used to manage accounting information within management server (i.e.

remote server))


*Conclusion*

**THIS ACTION IS MADE FINAL.**  Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to KYUNG H. SHIN whose telephone number is (571) 272-

3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan J. FLYNN can be reached on (571) 272-1915. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyung Hye Shin
Examiner
Art Unit 2143

KHS
July 12, 2008

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2143